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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,766	09/22/2003	James J. Lloyd	LOYDJ-001C2G	1363
7590	07/27/2004			EXAMINER
Kit M. Stetina, Esq. STETINA BRUNDA GARRED & BRUCKER Suite 250 75 Enterprise Aliso Viejo, CA 92656			COOLEY, CHARLES E	
			ART UNIT	PAPER NUMBER
			1723	
			DATE MAILED: 07/27/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,766	LLOYD, JAMES J.	
	Examiner	Art Unit	
	Charles E. Cooley	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24-31 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) 47-50 is/are withdrawn from consideration.
- 5) Claim(s) 24-31 is/are allowed.
- 6) Claim(s) 44-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 24-31 and 44-50 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election By Original Presentation

1. Newly submitted claims 47-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 47-50 are drawn to a patentably distinct species of the claimed invention (i.e., the embodiment of Figures 6-7 with the frangible wall) which was not claimed upon filing of the application and therefore not searched or examined on the merits. If such subject matter drawn to the species of Figures 6 and 7 were presented in the originally filed claims, the application would have been subject to an election of species requirement as required in the prosecution of one or more of the parent applications (e.g., see Paper No. 4 of the preceding parent application 10/109,524). Furthermore, since all generic claims stand rejected in this final rejection, Applicant is not entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly presented claims 47-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The amended title of the invention and abstract are acceptable.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Marquardt (US 5,050,775) in view of Wright (US 5,085,346).

The patent to Marquardt discloses a method of forming a portable beverage delivery system (col. 1, lines 4-20 and col. 2, lines 26-34) comprising forming a freestanding and portable housing 22 (Fig. 7); the housing 22 segmented into a first portion 20 and a second portion 36; the first portion 20 and the second portion 36 being laterally formed with respect to each other (when viewing Fig. 7 rotated 90 degrees to the right); forming a first opening 112 (Fig. 3) and a second opening 70 in the housing; inserting a chamber 24 into the first portion 20; the chamber 24 having a closeable introduction aperture 26 and a closeable exit aperture 30 respectively exposed through the first opening 112 and the second opening 70 of the housing; the chamber 24 filled with a mixer beverage (col. 2, lines 30-24). Marquardt does not disclose inserting a container having an aperture into the second portion of the housing that is capable of receiving a fluid. The patent to Wright discloses a system comprising a housing 11; a chamber 34 disposed within the housing for holding a fluid 42; the chamber 34 having a single closeable introduction aperture and exit aperture 30

controlled by a valve 31; the housing having a first portion or compartment 19 for holding the chamber 34 and a second portion or compartment 21 which holds a container 36 or 36a which contains a fluid component; the container 36 or 36a having an aperture (note container 36 must inherently have an aperture such that it can be filled as described at col. 3, lines 57-65 and the well known prior art spray container 36a shown in Fig. 3 and likely present in most households inherently has an aperture proximate the top of the container and adjacent the spray nozzle). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have inserted a fluid holding container with an aperture into the second portion 36 of Marquardt as disclosed by Wright for the purpose of permitting the chamber in the first portion of the housing to receive contents of the container in the second portion of the housing or, conversely, the container to receive contents of the chamber (col. 3, line 57 through col. 4, line 27).

5. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marquardt (US 5,050,775) in view of Wright (US 5,085,346) as applied to claim 44 above and further in view of Mullen et al. (US 5,673,817).

Marquardt in view of Wright does not disclose filling the container with an alcoholic beverage. The patent to Mullen et al. (US 5,673,817) discloses a system comprising a housing 13 with multiple portions 17a, 17b, and 17c; a chamber 21 which may include a mixer beverage therein (col. 1, lines 9-15) and which is accommodated within a portion of the housing (Fig. 1); a compartment in the housing (e.g., the opening within the housing 13 defined by 17c); a container 21 which may include an alcoholic

beverage therein (such as wine: col. 1, line 14 or col. 5, lines 46-47) removably supported in the compartment; the housing being segmented into the multiple portions 17a, 17b, and 17c via walls (the walls of the housing proximate 13 in Fig. 2); the chamber 21 being fabricated from plastic material (col. 2, lines 57-58); the compartment having upper and lower border structures (Fig. 2); the container 21 having top and bottom portions (Fig. 3); the upper and lower border structures retaining the top and bottom portions of the container (Fig. 1); the compartment defining a void (the perimeter defined about 17c) which displays the container when the container is supported in the compartment (as the front 23 of the container is clearly visible when the container is placed in the compartment as seen in Figure 1). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have substituted the second liquid component in Marquardt in view of Wright with an alcoholic composition as disclosed by Mullen et al. for the purpose of forming a beverage (which Marquardt teaches) with alcohol therein.

Allowable Subject Matter

6. Claims 24-31 are allowed.

Response to Amendment

7. Applicant's arguments filed 24 JUN 2004 have been fully considered but they are not deemed to be persuasive.

Applicant argues that it is not obvious to insert a container into the second portion of the housing of Marquardt because the container would not be able to lie flat because of the presence of the cap 28 and any indicia would be marred. The general concept of inserting a container into the second portion of the housing of Marquardt is suggested by the overall teachings of Wright as set forth in the rejection above. Although the particular orientation of the container in the housing is not at issue in the pending claims, note Fig. 3 of Marquardt which depicts the hole or opening 112 for receipt of the filler 26 portion of the chamber 24. The planar surface 94 about the opening 112 is quite generous in relative dimensions and note the cap extends above the planar surface 94 as seen in Fig. 7 and thus only occupies a small area of the surface 94. Accordingly, Applicant's conclusion that a container could not lie flat in the second portion of the housing is premature. Note a container could be situated above or below or over the flaps 114 and thus the presence of a container in the second portion of the housing would not be precluded merely by the presence of the cap. Applicant's assertion that indicia would be marred is of no patentable consequence since the claims are devoid of any subject matter regarding "indicia" and Applicant's position on this point is considered to be speculative attorney's argument unsupported by objective technical evidence on the issue. Arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)

The arguments regarding "a single aperture" as recited in claim 44 are not germane to patentability since the applied prior art to Wright either shows and/or

inherently suggests a container with just one aperture as Applicant apparently intends to claim. However, for purposes of clarifying the record or for appeal, the examiner considers the scope of the pending and elected claims to permit a container with a multitude of apertures to meet the claimed subject matter of "a single aperture" since Applicant employs the ubiquitous transitional phrase "comprising". The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). Accordingly, the examiner considers a prior art container with 1 or 100 apertures to meet the limitations of the container set forth in part (d) of new claim 44.

Applicant's arguments with respect to claims 47-50 are immaterial since these claims are properly withdrawn by original presentation as explained above.

In conclusion, the amendments made in the instant application are not deemed of a substantive nature to define over the prior art and thus the rejections are considered proper.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles E. Cooley
Primary Examiner
Art Unit 1723

23 JULY 2004